

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Linda Ann Roberts et al.

Art Unit 3627

Application No. 10/008,295

Examiner Steven B. McAllister

Filing Date: 11/13/2001

Confirmation No. 2697

For: Systems and Methods for Processing
an Electronic Request for Goods or
Services

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Appeal Brief is filed in connection with the Notice of Appeal that was filed on January 23, 2006, in this application.

This appeal is from the decision of the examiner in the final Office Action mailed on September 23, 2005, rejecting all pending claims.

An authorization to charge the requisite Government fee to a credit card is filed with this Brief.

The Commissioner is authorized to charge any deficiency in fees in connection with this paper, and to credit any overpayment, to Deposit Account No. 50-2476.

I. REAL PARTY IN INTEREST

The real party in interest is BellSouth Intellectual Property Corp., 824 Market Street, Suite 510, Wilmington, Delaware 19801, which is the owner of this patent application by operation of an Assignment recorded at Reel 012363, Frame 0218, on November 13, 2001.

II. RELATED APPEALS AND INTERFERENCES

None

III. STATUS OF CLAIMS

Claims 1, 3-7, 9-12, and 15 are pending.

The Examiner's decision finally rejecting the pending claims is appealed to the Board of Patent Appeals and Interferences. A correct copy of the claims on appeal is included in the Appendix attached to this Brief.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the appealed-from final Office Action mailed on September 23, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicants' methods (Claim 1) and computers (independent Claims 7 and 12) relate to processing electronic requests to purchase goods or services, for example using the internet. The following discussion relates exemplary features of the Claim 1 and exemplary portions of the written description. Independent claims 7 and 12 include features that are substantially the same for purposes of this discussion. Thus, all pending dependent claims also include such features.

To perform a transaction, a shopper is provided with "an electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information". Claim 1; see application at p. 5, ll. 10-22. The "notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs". Claim 1; see application at p. 5,

I. 22 - p. 6, I. 23. There is created "a shopper profile associated with the shopper . . . [and] containing the electronic request and the optionally supplied notification information". Claim 1; see application at p. 6, II. 24-29; p. 8, II. 21-24; and FIG. 6. When "the occurrence of the triggering event" is recognized, "the notification information in the shopper profile" is accessed, and the shopper is notified of a changed delivery date. Claim 1; see application at p. 7, II. 5-25.

The claimed methods and computers offer a number of advantages over prior methods and apparatus. For example, the claimed subject matters enable electronic purchasers to be informed of delivery changes just as conventional purchasers have been. See application, p. 2, II. 21-31.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 6, 7, 9, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over a combination of U.S. Patent No. 6,728,685 to Ahluwalia ("Ahluwalia") and U.S. Published Patent Application No. 2003/0149640 to Fisher et al. ("Fisher").

Remaining dependent claims 4, 5, 10, and 11 stand rejected under Section 103(a) as unpatentable over a combination of Ahluwalia, Fisher, and "Presence Technology to Make Its Debut Shortly", http://www.mobileinfo.com/News_2001/Issue25/Presence_tech.htm ("Presence").

VII. ARGUMENT

Three criteria must be met to establish a prima facie case of obviousness. First, the cited documents must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the cited documents themselves or in the knowledge generally available to one of ordinary skill in the art, to have combined the teachings of the cited documents. Third, there must have been a reasonable expectation that the documents could have been successfully combined.

None of the rejections can stand at least because no combination of Ahluwalia, Fisher, and/or Presence teaches all of the claim limitations. Moreover, the cited documents would not have supplied any motivation to combine them as suggested by

the Action. Finally, there would have been no reasonable expectation that such complex documents could have been successfully combined to yield a working system, which even then would have had to be further modified to obtain the claimed subject matters.

A. The Combination of Ahluwalia and Fisher Neither Discloses nor Would Have Suggested the Inventions Defined by Independent Claims 1, 7, and 12 and Their Dependent Claims 3, 6, 9, and 15

Claim 1 for example recites the step of "providing to a shopper, via a communications network, an electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs". The other independent Claims 7 and 12 include comparable recitations.

Ahluwalia relates to on-line order reporting systems and methods for consumer products having specific configurations. Ahluwalia, col. 1, ll. 56-60. A consumer is provided real-time information, before placing an order, regarding the availability and status of a configured product (in particular, an automobile) in relation to the product's manufacturing and delivery process. Ahluwalia, col. 2, ll. 60-67. The consumer may submit a tag order to a web site or portal, which receives vehicle configuration, pricing, and inventory information. Ahluwalia, col. 20, ll. 8-18. As described in Ahluwalia at col. 10, ll. 28-35, a consumer "may further select a means of reporting the vehicle delivery status and a frequency for the report".

Page 2 of the final Action mailed on September 23, 2005, admitted that "Ahluwalia does not explicitly show that the notification is to be in the case of a triggering event; recognizing the occurrence of the triggering event; and notifying the shopper that the triggering event has occurred." Indeed, at col. 10, ll. 28-35, all that Ahluwalia states about notifications is that they occur at times that are preset (e.g., every week or month) and may include various information, such as updated delivery dates. Ahluwalia's selected frequency says nothing about and would not have

suggested any of notifying only in case of triggering events, or recognizing triggering events or, perforce, notifying that triggering events have occurred.

Fisher discloses a method for disclosing the status of an order to a customer by way of a customer's network address. Fisher, paragraph 0011. A status requester computer program periodically interrogates a computer, such as that of a shipping service, for status information, which is stored and in turn periodically checked. Fisher, paragraphs 0021, 0022. If a status record has changed, an e-mail message based on the new status information is transmitted to the customer. Fisher, paragraph 0022. The e-mail messages come unbidden by the customer, as according to Fisher this is a purported advantage. Fisher, paragraph 0007.

Page 3 of the Action mailed on April 6, 2005, admitted that Fisher fails to teach "providing the shopper with an electronic purchase order having an opportunity to select a notification option on the purchase order and providing electronic purchase information, or notifying the shopper of the triggering event only if a notification option has been selected". The Action did not admit enough. Indeed, at paragraphs 0021 and 0022, all that Fisher states about notifications is that they occur at every status change, whatever that change might be, and without request by the customer. Thus, Fisher's notifications say nothing about and would not have suggested any of notifying only in response to customer selection and only in case of triggering events that affect performances of deliveries, or recognizing triggering events that affect performances of deliveries or, perforce, notifying that such triggering events have occurred.

As both Ahluwalia and Fisher fail to describe anything like the notification features as claimed, any combination of Ahluwalia and Fisher would also have lacked those claimed features. Accordingly, these documents cannot meet the requirements of a prima facie case against claims 1, 3, 6, 7, 9, 12, and 15, and thus the obviousness rejections of these claims must be withdrawn.

The second requirement of a prima facie case is also missing here. One of ordinary skill in this art would have had no motivation to combine Ahluwalia and Fisher at least because these documents teach away from such a combination.

As noted above, in Ahluwalia a consumer "may further select a means of reporting the vehicle delivery status and a frequency for the report", but Fisher states

that one of its advantages is that "the customer is not required to take any action to receive this notification". Ahluwalia, col. 10, ll. 28-35; Fisher, paragraphs 0007, 0010.

In addition, Fisher addresses a "need in the art . . . for automatically notifying a party . . . without requiring . . . special profile information from the party". Fisher, paragraph 0010. Nevertheless, customer profiles are described in Ahluwalia in connection with FIGs. 3 and 18. In particular with respect to FIG. 18, "Customer profile data 1303 are also stored into common membership database 672 via common membership database interface 670". Col. 20, ll. 16-18.

Because requiring a user to opt for notification and to provide profile information would destroy the advantages of Fisher or would purposefully change the features of Ahluwalia, it is hard to understand why one knowing of Ahluwalia and Fisher would have been motivated to combine them. The suggestion to combine such disparate documents, with several indications against any motivation for the combination in the documents themselves, may reflect a use of Applicant's claims as mere templates for picking isolated features from the art. Such hindsight reconstruction is improper. E.g., Sensonics, Inc. v. Aerosonic Corp., 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996); In re Oetiker, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (reversing an obviousness rejection and stating the "reason, suggestion, or motivation" to combine (or modify) prior art "can not come from the applicant's invention itself. [Citation omitted.]").

The third requirement of a prima facie case is also missing. The Action's suggestion that Ahluwalia and Fisher can be combined ignores the great technical differences between them that would have made the success of such a combination improbable to say the least. Moreover as discussed above, the features of Ahluwalia and Fisher cannot be combined without further modification to reach the subject matter defined by the claims. In the absence of any suggestion in the cited documents of how to make such a combination operable, one would have faced a serious engineering problem that naturally would have had a low probability of success without substantial experimentation and effort, especially in view of the need to modify the teachings of the documents. It is well settled that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make that modification obvious unless

the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Accordingly, the obviousness rejections of claims 1, 3, 6, 7, 9, 12, and 15 are improper and should be reversed.

- B. The Combination of Ahluwalia, Fisher, and Presence Neither Discloses nor Would Have Suggested the Inventions Defined by Dependent Claims 4, 5, 10, and 11

The Presence document is directed to various automated methods for communicating with a person using the person's status, communications capabilities, and preferences at any particular moment.

Nevertheless, Presence also fails to teach or suggest the features missing from Ahluwalia and Fisher. In particular, Presence fails to disclose an "electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs" as recited in Claim 1 and as similarly recited in Claim 7, which are the bases for Claims 4, 5, 10, and 11.

Thus, the obviousness rejections of Claims 4, 5, 10, and 11 are improper and should be reversed for lack of a prima facie case on the same grounds as the obviousness rejections of Claims 1 and 7.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections of Claims 1, 3-7, 9-12, and 15 under 35 U.S.C. § 103(a) are improper. It is accordingly requested that the rejections be reversed and that this application be returned to the Examiner with directions that it be allowed.

Potomac Patent Group PLLC
P.O. Box 270
Fredericksburg, VA 22404
Tel: 919 928 9979
Date: July 14, 2006

Respectfully submitted,

/Michael G. Savage/

Michael G. Savage
Registration No. 32,596

VIII. CLAIMS APPENDIX

1. A method for processing an electronic request to purchase goods or services, the method comprising:

providing to a shopper, via a communications network, an electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs;

receiving from the shopper, via the communications network, the electronic purchasing information that contains an electronic request to purchase goods or services and, if the notification option was selected, optionally supplied notification information, the notification information representative of at least one communication pathway for communicating with the shopper;

creating a shopper profile associated with the shopper, the shopper profile containing the electronic request and the optionally supplied notification information;

providing the shopper with delivery information;

recognizing the occurrence of the triggering event that affects the performance of the delivery;

accessing the notification information in the shopper profile;

if the shopper has selected the notification option and supplied the notification information, notifying the shopper that the triggering event has occurred via the at least one communication pathway; and

notifying the shopper of a changed delivery date.

2. (Canceled)

3. The method of claim 1, wherein receiving notification information further comprises receiving one of an email address, a telephone number and a pager number.

4. The method of claim 1, wherein receiving notification information further comprises receiving presence information.

5. The method of claim 1, wherein the notification information further comprises a plurality of communication pathways, each pathway having a preferred rank.

6. The method of claim 1, wherein the communications network is the Internet.

7. A computer having instructions thereon for processing an electronic request to purchase goods or services, the instructions performing the steps comprising:

providing to a shopper, via a communications network, an electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs;

receiving from the shopper, via the communications network, the electronic purchasing information that contains an electronic request to purchase goods or services and, if the notification option was selected, optionally supplied notification information, the notification information representative of at least one communication pathway for communicating with the shopper;

creating a shopper profile associated with the shopper, the shopper profile containing the electronic request and the optionally supplied notification information if the notification option was selected;

providing the shopper with delivery information;

recognizing the occurrence of the triggering event that affects the performance of the delivery;

accessing the notification information in the shopper profile;

if the shopper has selected the notification option and supplied the notification information, notifying the shopper that the triggering event has occurred via the at least one communication pathway; and

notifying the shopper of a changed delivery date.

8. (Canceled)

9. The computer of claim 7, wherein receiving notification information further comprises receiving one of an email address, a telephone number and a pager number.

10. The computer of claim 7, wherein receiving notification information further comprises receiving presence information.

11. The computer of claim 7, wherein the notification information further comprises a plurality of communication pathways, each pathway having a preferred rank.

12. A server computer for processing an electronic request to purchase goods or services from a shopper, the server comprising:

a communications interface connected to a communications network, said communications interface establishing a communications link between the server and a host client computer;

a processing engine in communication with the communications interface, wherein the processing engine has a microprocessor, said microprocessor executing computer-readable instructions stored on a tangible medium, wherein said execution of the instructions causes the processing engine to

provide to the shopper a purchase order having an opportunity to select a notification option, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs, receive purchasing information from the shopper via the host client computer and the communications network, the purchasing information containing an electronic request to purchase goods or services, and, if the notification option was selected, optionally supplied notification information representative of at least one communication pathway for communicating with the shopper;

provide the shopper with delivery information;

recognize the occurrence of the triggering event that affects the performance of the delivery;

notify the shopper that the triggering event has occurred via the at least one communication pathway if the shopper has selected the notification option and supplied the notification information; and

notify the shopper of a changed delivery date; and

a data storage facility in communication with the processing engine that stores data representing the notification information and a shopper profile associated with the shopper and containing the electronic request and the notification information associated with the shopper.

13. (Canceled)

14. (Canceled)

15. The server system of claim 12 further comprising:

a message routing agent adapted to receive notification information.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None

TABLE OF CONTENTS

	<u>PAGE</u>
I. <u>Real Party in Interest</u>	2
II. <u>Related Appeals and Interferences</u>	2
III. <u>Status of Claims</u>	2
IV. <u>Status of Amendments</u>	2
V. <u>Summary of the Claimed Subject Matter</u>	2
VI. <u>Grounds of Rejection to Be Reviewed on Appeal</u>	3
VII. <u>Argument</u>	3
A. The Combination of Ahluwalia and Fisher Neither Discloses nor Would Have Suggested the Inventions Defined by Independent Claims 1, 7, and 12 and Their Dependent Claims 3, 6, 9, and 15	4
B. The Combination of Ahluwalia, Fisher, and Presence Neither Discloses nor Would Have Suggested the Inventions Defined by Dependent Claims 4, 5, 10, and 11	7
<u>Conclusion</u>	7
VIII. <u>Claims Appendix</u>	8
IX. <u>Evidence Appendix</u>	11
X. <u>Related Proceedings Appendix</u>	11